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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,704

02/06/2004

Joseph L. Ungari

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05/16/2006

BANNER & WITCOFF, LTD.

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BOSTON, MA 02109-9601

EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/774,704

Applicant(s)

UNGARI, JOSEPH L.

Examiner

Anthony Stashick

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3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-19, 21-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parihar et al. 2004/0002665 in view of Sasaki et al. 5,230,249. Parihar et al. '665 discloses all the limitations substantially as claimed including the following (see Figure 5): a sole structure 514; an upper 500 (noted as shoe but shown in Figure 5 to be pointing to the upper of the shoe) secured to the sole structure; at least one reservoir of magneto-rheological fluid in at least one of the upper and the sole structure 504; and a magnet assembly 510 proximate each reservoir; wherein a magnetic field produced by the magnet assembly transforms the magneto-rheological fluid from a fluid state to a near-solid state (see paragraphs [0116-0118]); the magnet assembly comprises a plurality of permanent magnets 510; when the article of footwear is in a first condition the permanent magnets are spaced apart from the reservoir (uncompressed state, i.e. when the user's foot is not in the shoe) and the magneto-rheological fluid is in a fluid state, and when the article of footwear is in a second condition (with user's foot in shoe) the permanent magnets are proximate the reservoir and create a magnetic field within the reservoir and transforms the magneto-rheological fluid into a near-solid state; the magnet assembly comprises a plurality of electromagnets 510; a load cell 518 configured to activate the electromagnets upon detection of a force from a user's foot; the load cell is positioned in the sole structure (see Figure 5); a power source 512 connected to the electromagnets; the power source comprises a battery 512; the magnet assembly comprises a plurality of magnets 510 on a first side of a reservoir and a plurality of magnets 510 on an opposed second side of the reservoir (see Figure 5); the magneto-rheological fluid comprises magnetic

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particles suspended in oil (see paragraph [0011]); the magneto-rheological fluid comprises iron molecules suspended in silicon (MR fluids known to be contain silicon or oil); the reservoir of magneto-rheological fluid is located in a compressible support element 504 secured to a bottom surface (bottom of insole) of the sole structure. Parihar et al. '665 does not disclose the reservoir of magneto-rheological fluid being located in the upper or sidewall of the upper, the load cell positioned in the sidewall of the upper and a reservoir located in both the medial and lateral sidewalls of the upper. Sasaki et al. '249 teaches that for support to be given the user's foot to prevent rolling of the user's foot within the shoe, the upper of the shoe can have reservoirs 5C located on each side of the upper to give support to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place reservoirs of MR fluids in the upper of the user's shoe to aid in giving varying support to the user's foot during use depending upon the support desired.

3. Claims 4, 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3, 19 and 31 above, in view of Demon 5,813,142. The references as applied to claims 3, 19 and 31 above disclose all the limitations of the claims except for the article of footwear transforming from one state to another upon detection of a force from a user's foot. Demon '142 teaches that the support of a shoe can be adjusted based upon the force felt upon the shoe by the user's foot during use, by using sensors to send signals to an internal computer to adjust the rigidity of the supports. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place sensors in the support of the references as applied to claims 3, 19 and 31 above, to detect when more support was needed to activate the magnets to give more support to the user's foot during use.

*Response to Arguments*

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the combination of Parihar and Sasaki is improper because the reservoir of Sasaki is designed to keep the pressure the same in the chamber and not vary that pressure. The inventions disclosed in both Sasaki and Parihar are used to solve the same problem of providing cushioning to the user's foot during impact and making sure that the cushioning provided is similar for each impact. Sasaki does it by keeping the pressure in the bladders the same whereas Parihar does it by using magnetic rheological fluid to keep the support/cushioning the same. Applicant's argument that the pressure in the Sasaki device doesn't vary contradicts the teaching of Sasaki. Sasaki teaches that a user can set the pressure, i.e. a different pressure or support desired by different user's, and therefore, the pressure of Sasaki can vary depending upon what is desired. Applicant's support only changes when a force is applied to the reservoir, similar to the force applied to the reservoir of Sasaki, and therefore, since Sasaki would adjust those pressures at that time to the one desired, so would applicant's invention adjust to retain the same support for the user's foot, therefore Sasaki does not teach away from a reservoir with varying pressure but only teaches the reservoir with varying pressure being different. Parihar acts in a similar fashion in changing the support to that desired based upon the pressure applied. Therefore, the combination of Parihar with Sasaki is proper. Since the reservoir in Sasaki is used to give support to the user's foot and the reservoir in Parihar is used for the same purpose, it would have been obvious to one of ordinary skill in the art that these reservoirs are interchangeable.

*Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

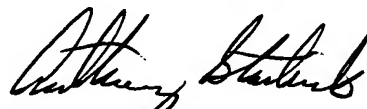
Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS